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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,505	03/27/2006	Yoshitsugu Morita	71,051-029	3561

27305 7590 07/31/2008
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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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07/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,505	Applicant(s) MORITA ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/08/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(a) and/or 35 U.S.C. 102(e) as being anticipated by WO 2004/037927. This reference teaches precisely the same invention as that which is claimed. The inventive entities are, in fact, different and, thus this reference is available under both paragraphs of section 102. It should be noted that the Examples contemplate the employment of an organohydrogensiloxane wherein the endgroups are dimethylhydrogensiloxy groups.

Claims 1-3 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Issihiki et al., U.S. patent # 6,225,433. Isshiki discloses a silicone composition comprising the materials outlined in column 2, lines 10-32. It is said of component (D) in column 4, lines 29-34 that branched chain structures are a preferred permutation of this component for the exemplary degassing behavior it helps to convey. Both components (A) and (D) are required to have a specific amount of aryl group content

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(column 2, lines 55-57 and column 4, lines 18-20). The stated viscosity range of (A) is consistent with an organopolysiloxane having between 5 and 1000 repeat units.

Semiconductor devices are the articles for which the prior art composition is formulated.

It is to be noted that the phenyl group content of components (A) and (D) are purposely different to lessen their compatibility. Given the implication that they are incompatible, it is difficult to see how the Examiner could rationalize holding the limitations of claims 6 and 7 as being inherently anticipated.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enami et al., U.S. patent # 6,001,943. Enami teaches a composition comprising the materials outlined in column 3, lines 16-34. Relevant to the present discussion, it is said of component (A) that it preferably comprises a mixture of linear-

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and branched alkenyl-functional polysiloxane (column 3, lines 54-62) in the relative quantities advocated by column 4, lines 43-48. The reported viscosity of these materials (column 3, line 21) is consistent with a polymer having the degree of polymerization stipulated in claim 3. In column 4, there is provided a description of five favored embodiments of the linear polymer, two of which contain aryl group-substitution. Further, it is contemplated in the paragraph bridging columns 3 and 4 that the branched polymer may have aryl substitution. Because there are only a small number of exemplary linear polymers mentioned and two of these contain aryl groups, the Examiner believes that an embodiment wherein both branched and linear polymer contain aryl substitution is obvious. The relative amounts of these two polymers present in component (A) is identified in column 4, lines 43-48. As before, the viscosity of component (A) is consistent with a polymer having 5 to 1000 repeat units.

The compositions taught therein are used to seal electric parts including semiconductors.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 9, and 11-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 10, 14, and 17-20 of U.S. Patent No. 7,282,270. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only distinction between the present claims and those of the patent is that the former contemplate only those organohydrogensiloxanes that contain SiH moieties at each end whereas the patent claims disclose all manner of organohydrogensiloxane provided that it contains at least two hydrosilyl groups. On the other hand, the practical examples outline a composition for which hydrosilyl group-terminated polydiorganosiloxane is the crosslinker of choice. Insofar as the claims do not delineate what are the favored permutations of this component, it would be appropriate to consult the Specification to ascertain what materials were envisaged to fulfill this role. (MPEP 804 instructs that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In re *Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is

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an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim.

Terreau et al., U.S. Patent Application Publication No. 2006/0207646 and Staiger et al., U.S. Patent # 7,153,914 are notable for their disclosure of similarly-constituted compositions however neither document qualifies as prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 29, 2008

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796